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09/491,899	01/27/2000	William R. Wells	3735-929	9213

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EXAMINER
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MAHMOUDI, HASSAN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Request for Continued Examination (RCE) submission and the accompanying amendment filed on 09-May-2006 have been entered.

### ***Remarks***

2. In response to amendment filed on 09-May-2006, claims 21-23 are canceled and claims 1-3, 5, 8-10, 12, 24, and 28-30 are amended per applicant's request. Therefore, claims 1-3, 5-6, 8-10, 12-13, and 24-30 are presently pending in the application, of which, claims 1, 8, and 24 are presented in independent form.

### ***Priority***

3. The instant application claims benefit of the filing date to the U.S. Provisional Application S/N 60/153,745, filed on 13-September-1999. Accordingly, the filing date of the Provisional Patent Application (13-September-1999) is considered the effective filing date for the examination of the instant application.

***Specification***

4. The specification amendment filed on 16-April-2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

“These cards may be of conventional dimensions, having a thickness less than about ¼ inch, or less than 0.05 inch”, inserted in page 2 of the specification amendment filed on 16-April-2004, relating to the last complete paragraph of page 4 of the originally filed specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

The Examiner apologizes for not citing the “new matter” in the referenced amendment earlier, due to transfer of the instant application from another Examiner, and regrets any inconveniences caused by this unintentional oversight.

***Duplicate Claims***

5. Amended claim 30 (amended by Applicant to depend directly from independent claim 1) is now a duplicate of amended claim 2, which is also directly dependent from claim 1.

Applicant is advised that should claim 2 be found allowable, claim 30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the ***first paragraph*** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 2, 9, 25 and 30 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 2 and 30 recite the limitation, “wherein said smart card has a thickness of less than about 0.05 inch”; claim 9 recites, “wherein said step of storing includes storing in a smart card having a thickness less than about 0.05 inches”; and claim 25 recites, “in which said card has a thickness of less than about one quarter inch”.

Nowhere throughout the originally filed specification, does any reference exist for the “thickness” of the card measured in inches or fraction of inches. In fact, this limitation was added to the specification in the amendment filed on 16-April-2004, and therefore constitutes “new matter”.

Again, the Examiner regrets any inconveniences caused by not citing this rejection earlier, as stated in paragraph 4 of this Office Action.

This rejection however can be overcome by amending the referenced claims to remove the reference made to the card thickness in inches, and by re-writing the claims' limitation in a manner supported in the original specification (e.g., "wherein the smart card has a profile about the size of a typical credit card" for claims 2, 9 and 30, and, "wherein the smart card has a profile thicker than the size of a typical credit card" for claim 25.)

Appropriate corrections are required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the *second paragraph* of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5, 12 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 (line2) and claim 12 (lines 3-4), recite the limitation "the current account balance"; and claim 27 (lines 2-3) recites "said current account balance". There is insufficient antecedent basis for these limitations in the claim.

Corrections are required.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. independent claims 1, 8 and 24 (and their dependent claims) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claims 1, 8 and 24 recite, “if there is a match, outputting an authorization allowing the player to access his or her account...”. The results of these claims, although considered useful and tangible (“outputting an authorization”), are not concrete and therefore, not considered as statutory subject matter.

In the above claims, the results are conditional (the “outputting” of “an authorization” only takes place “*if* there is a match” between the biometric identification [e.g., fingerprint] stored on the player’s smart card and the biometric identification of the player read by the gaming device’s biometric reader/sensor.) The above claims do not clearly indicate what would happen *if there is not a match* between the two biometric identification data (e.g., if the smart card is used by a player other than the owner of the smart card, whose biometric data is stored on the card.) Therefore, the results of the above claims are conditional and are not guaranteed to be produced every time.

This rejection can be overcome by amending the independent claims to clearly indicate a result in case of a mismatch in the comparison step of the claims (e.g., “and outputting an error message to the user indicating that the playing of the game is not allowed”; or sending a

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message to another party indicative of possible fraudulent attempt, etc.), provided that there is sufficient support in the *originally filed* specification of the instant application.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 6, 8, 12-13, 24, 26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orus et al (U.S. Publication No. 2004/0035926 A1, hereinafter referred to as Orus) in view of Soltesz et al (U.S. Publication No. 2001/0011680 A1, hereinafter referred to as Soltesz.)

As to claim 1, Orus teaches a gaming apparatus to be played by a player (see elements 200, 200' and 200" in figure 1 and see paragraphs 1, 5, 8, 12, and 24, where "gaming apparatus" is read on "gambling machine", and "player" is read on "gambler"), comprising:

a portable smart card carried by the player (see paragraphs 2, 5 and 30-31, where a smart card" is read on a "chip card"); said biometric smart card carried by the player separate from the gaming apparatus (see paragraph 49, where "player" is read on "gambler", and the fact



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that the gambler “hands his gambling card to the operator” indicates that the player/gambler carries the card with him, separately from [not attached to] the gaming apparatus);

a gaming terminal (see element 200 in figure 1 and see “gambling machine” in paragraph 24), configured for playing at least a first game (see paragraphs 57 and 76, where “playing a game” is read on “placing bets”);

a reader, coupled to the gaming terminal (see card reader 210 coupled to gambling machine 200 in figure 1 and see paragraphs 5 and 26) which receives data stored on said smart card (see paragraphs 14 and 56, where “receiving data” is read on “reading data”); and

a comparator for comparing data (see paragraphs 63 and 91) and if there is a match, outputting an authorization allowing the player to use a cash balance on the smart card to play the gaming apparatus (see “gambling operation is authorized” in paragraph 63.)

**Orus** does not teach:

a biometric smart card storing biometric data for the player;

a reader which receives biometric data stored on said smart card;

a biometric measurement device for measuring biometric data of a user to provide measured biometric data; and

a comparator for comparing said measured biometric data to the biometric data stored on said smart card and if there is a match, outputting an authorization allowing the player to access his or her account.

**Soltesz** teaches a biometric enabled self-service kiosk (see paragraphs 3-4 and 10), in which he teaches:

a biometric smart card storing biometric data for the player (see paragraphs 4, 13 and 19, where “smart card” is read on “optical/memory card”);

a reader which receives biometric data stored on said smart card (see element 2 in figure 1, and see paragraphs 28 and 30-31);

a biometric measurement device for measuring biometric data of a user (see element 3 in figure 1, and see paragraph 14, where biometric measurement device” is read on “biometric input/reader device”) to provide measured biometric data (see paragraphs 13 and 31-32); and

a comparator (see paragraph 29) for comparing said measured biometric data to the biometric data stored on said smart card (see paragraphs 14, 29, 31 and 38) and if there is a match, outputting an authorization allowing the player to access his or her account (see paragraph 14, where “accessing the account” is read on “authorizing a transaction”; and see paragraphs 29, 31, and 38.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Orus by the teachings of Soltész, because “a biometric smart card storing biometric data for the player; the gaming machine to be coupled to a card reader for receiving the user’s biometric data stored on the smart card; a biometric reader to capture a user’s biometric data; and a comparator to allow the game to be played”, would provide both convenience and security for the player to use his smart card to play different games at different gaming machines (e.g., in a casino) using the same card and same account cash/token balance on the card. This enables the player to walk around in the casino cash-free without risking losing his cash or having to carry lots of coins around. Storing user’s biometric data (e.g., fingerprint) on the user’s card would prevent unauthorized use of

the card should the card be stolen or lost and recovered by another player. When a player inserts a card into a gaming machine, he/she would also provide his/her biometric data (e.g., fingerprint) to the machine in real-time, which would then be compared with the biometric data stored on the card to verify that the game card is being used by the authorized user, therefore, preventing fraudulent transactions. In general, Soltesz solves the “prior art problems” of storing biometric information in databases and onsite, as opposed to storing them on portable devices such as smart cards, which he lists as follows: “The principal problem with the use of biometrics to verify cardholders in this context is the problem of communicating the biometrics information to the database, and communicating the results back to the site of the transaction. Storage of biometrics information on site is generally impractical, and is certainly inefficient when the card can be used with different kiosks, each of which would be required to store the necessary information. As a result, the use of biometrics information is limited to transaction devices which are networked or equipped to communicate with a remote database. This limits the range of applicability of biometrics verification to use in connection with existing networks and locations with appropriate infrastructure, thereby excluding much of the world, and also limits the speed at which transactions can be conducted (paragraph 9).” The combination of the gaming apparatus of Orus with the teachings of Soltesz would enable the gaming devices/terminals of Orus to function similar to the portable kiosks of Soltesz and provide the gaming convenience and security (as mentioned above) to game players.

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As to claim 6, Orus as modified, teaches wherein:

said biometric measurement device is selected from among a thumb print scanner; a fingerprint scanner; a retina scanner; an iris scanner; an ear scanner; a voice data sensor; a facial scanner; or an infrared scanner (see “biometric reader device” in Soltesz, paragraphs 14 and 19; “image capture device” in paragraph 19; “biometric input device” in paragraphs 16, 21, and 28; and see “fingerprint reader” in paragraphs 31 and 44.)

As to claim 8, Orus teaches a gaming method (see paragraphs 2-3) for a gaming apparatus to be played by a player (see elements 200, 200' and 200'' in figure 1 and see paragraphs 1, 5, 8, 12, and 24, where “gaming apparatus” is read on “gambling machine”, and “player” is read on “gambler”), comprising:

storing first data for a player (see paragraphs 12, 14, 16) in a portable smart card carried by the player (see paragraphs 2, 5 and 30-31, where a smart card” is read on a “chip card”), which smart card is carried by the player separate from the gaming apparatus (see paragraph 49, where “player” is read on “gambler”, and the fact that the gambler “hands his gambling card to the operator” indicates that the player/gambler carries the card with him, separately from [not attached to] the gaming apparatus), and also storing personal preference data for said player in said smart card (see paragraphs 12 and 18, where “personal preference data” is read on “card balance”; and read on “information on the gambler”);

providing a gaming terminal (see element 200 in figure 1 and see “gambling machine” in paragraph 24);

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coupling a reader to said gaming terminal (see card reader 210 coupled to gambling machine 200 in figure 1 and see paragraphs 5 and 26), configured for playing at least a first game (see paragraphs 57 and 76, where “playing a game” is read on “placing bets”), wherein said reader receives said first data stored on said smart card (see paragraphs 14 and 56, where “receiving data” is read on “reading data”); and

comparing said data to said data stored on said smart card (see paragraphs 63 and 91); and if there is a match, outputting an authorization allowing the player to use a cash balance on the smart card to play the gaming apparatus (see paragraph 18; and see “gambling operation is authorized” in paragraph 63.)

**Orus** does not teach:

storing first biometric data for a player in a portable biometric smart card;

measuring biometric data of said player to provide measured biometric data; and

comparing said measured biometric data to said biometric data stored on said smart card

and if there is a match, outputting an authorization allowing the player to access his or her account.

**Soltesz** teaches a biometric enabled self-service kiosk (see paragraphs 3-4 and 10), in which he teaches the above.

For the above teachings, the applicant is directed to the remarks and discussions made in claim 1 above, in view of the teachings provided by **Soltesz**.

As to claim 12, Orus as modified, teaches wherein:

said smart card further stores the current account balance for an account established for said first user (see Orus, paragraphs 12, 46 and 53.)

As to claims 13 and 26, Orus as modified, teaches wherein:

said step of measuring includes a step selected from among: scanning a thumb print; scanning a fingerprint; scanning a retina; scanning an iris; scanning an ear; sensing voice data; or scanning a face (see “obtaining biometric data” in Soltesz, paragraphs 14 and 19; see “obtaining biometric data” from an “image capture device” in paragraph 19; and see “fingerprint reader” in paragraphs 31 and 44.)

As to claim 24, Orus teaches a gaming method (see paragraphs 2-3) for a gaming apparatus to be played by a player (see elements 200, 200' and 200” in figure 1 and see paragraphs 1, 5, 8, 12, and 24, where “gaming apparatus” is read on “gambling machine”, and “player” is read on “gambler”), comprising:

storing first data for a player (see paragraphs 12, 14, 16) in a portable smart card carried by the player (see paragraphs 2, 5 and 30-31, where a smart card” is read on a “chip card”), which smart card is carried by the player separate from the gaming apparatus (see paragraph 49, where “player” is read on “gambler”, and the fact that the gambler “hands his gambling card to the operator” indicates that the player/gambler carries the card with him, separately from [not attached to] the gaming apparatus) wherein said smart card also stores personal

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preference data for said player (see paragraphs 12 and 18, where “personal preference data” is read on “card balance”; and read on “information on the gambler”);

providing a gaming terminal (see element 200 in figure 1 and see “gambling machine” in paragraph 24);

coupling a reader to said gaming terminal (see card reader 210 coupled to gambling machine 200 in figure 1 and see paragraphs 5 and 26), configured for playing at least a first game (see paragraphs 57 and 76, where “playing a game” is read on “placing bets”), and reading said data stored on said card (see paragraphs 14 and 56, where “receiving data” is read on “reading data”); and

comparing said data to said data stored on said smart card (see paragraphs 63 and 91); and if there is a match, outputting an authorization allowing the player to use a cash balance on the smart card to play the gaming apparatus (see paragraph 18; and see “gambling operation is authorized” in paragraph 63);

reading from the same smart card a current account balance for an account established for said player (see paragraphs 27, 50 and 63); and

debiting an amount from said current account balance on said smart card as a fee for playing said game (see paragraphs 3, 14, 18 and 53), and establishing a new current account balance on said smart card (see paragraphs 27, 58, and 90.)

**Orus** does not teach:

storing first biometric data for a player in a portable biometric smart card;

measuring biometric data of said player to provide measured biometric data; and

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comparing said measured biometric data to said biometric data stored on said smart card and if there is a match, outputting an authorization allowing the player to access his or her account.

Soltesz teaches a biometric enabled self-service kiosk (see paragraphs 3-4 and 10), in which he teaches the above.

For the above teachings, the applicant is directed to the remarks and discussions made in claim 1 above, in view of the teachings provided by Soltesz.

As to claim 28, Orus as modified, teaches in which the player's winnings from play of said gaming apparatus are credited to said current account balance (see Orus, paragraphs 2-3, 14, 18, 27, 46, 57 and 76.)

As to claim 29, Orus as modified, teaches in which said smart card includes a microprocessor (see Orus, paragraphs 31, 33 and 68) and in which said smart card further stores a current account balance for an account established by said first user (see Orus, paragraphs 12, 46 and 53), in which the user's winnings from play of said gaming apparatus are credited to said current account balance (see Orus, paragraphs 2-3, 14, 18, 27, 46, 57 and 76.)

14. Claims 2-3, 5, 9-10, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orus in view of Soltesz, as applied to claims 1, 8 and 24 above, and further in view of Thompson (U.S. Patent No. 5,865,470.)



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As to claims 2, 9, and 30, Orus as modified, still does not *explicitly* teach wherein said smart card has a thickness of less than about 0.05 inch (Applicant is directed to paragraphs 4 and 6-7 of this Office Action, in view of the objection and rejections made to these claims regarding “new matter”).)

Nonetheless, Thompson teaches a peel-off coupon redemption card with microprocessor chip [smart card] (see figures 38-39 and see column 12, lines 51-64), in which he teaches the smart card has a thickness of less than about 0.05 inch (see column 4, line 44 through column 5, line 3.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Orus as modified, by the teachings of Thompson, because using smart cards which have a thickness of less than about 0.05 inch, would enable the system’s game cards to possibly also be used in other card readers (e.g., ATM machines or vending machines) to purchase snacks and/or obtain cash using the same gaming card on the premises, which would offer an additional convenience to the game player (at a casino, for example.) According to Thompson, “[c]onventional plastic credit cards are 0.021 to 0.027 inches in thickness. This is a standard thickness so that the plastic credit cards can be used in a machine that accepts plastic credit cards. All machines are designed to accept only this range of thicknesses for a plastic credit card” (column 4, lines 44-49.)

As to claims 3 and 10, Orus as modified, teaches wherein:

said smart card includes a microprocessor (see Orus, paragraphs 31, 33 and 68.)

As to claim 5, Orus as modified, teaches wherein:

said smart card further stores the current account balance for an account established for said first user (see Orus, paragraphs 12, 46 and 53.)

As to claim 27, Orus as modified, teaches in which the player's winnings from play of said gaming apparatus are credited to said current account balance (see Orus, paragraphs 2-3, 14, 18, 27, 46, 57 and 76.)

15. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Orus in view of Soltesz, as applied to claims 1, 8 and 24 above, and further in view of Nakata et al (U.S. Patent No. 5,736,727, hereinafter referred to as Nakata.)

As to claim 25, Orus as modified, still does not *explicitly* teach wherein said smart card has a thickness of less than about one quarter inch (Applicant is directed to paragraphs 4 and 6-7 of this Office Action, in view of the objection and rejections made to these claims regarding “new matter”).)

Nonetheless, Nakata teaches an IC communication card apparatus (see figure 1 and see column 2, lines 31-48), in which he teaches wherein said smart card has a thickness of less than about one quarter inch (see figures 7 and 8 and see column 4, lines 18-41, where “smart card” is read on “IC card” and “PC card”, and where the “card thickness of about 5 mm

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(millimeters)” translates to a thickness of about one fifth of an inch, which is less than about one quarter of an inch.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Orus as modified, by the teaching of Nakata, because having a smart card with a thickness of about 5mm (or one quarter inch) would enable the system to provide game players with a smart/IC card such as a PCMCIA card (or a customized smart card of the same thickness), which would not only provide additional security and/or functionality to the gaming machines/devices, but also due to the thickness of the card, misuse of the card would be prevented since the thickness of about one quarter inch is greater (thicker) than conventional/standard credit or debit cards, therefore, these cards cannot be used in ATM machines or in conventional credit/debit card authorization terminals, which would in turn, prevent fraudulent attempts by an unauthorized user, should the card be lost or stolen.

### ***Response to Arguments***

16. There are presently no arguments outstanding in the Application, as per Applicants last response filed on 09-May-2006. All previous arguments of record are considered moot in view of the new grounds of rejections presented in this Office Action.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

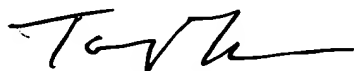
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The following patents are cited to further show the state of art with respect to methods and systems of automated gaming/gambling machines using the biometric identifiers stored on smart/IC/chip/memory cards in general:

Patent/Pub. No.	Issued to	Cited for teaching
US 6,213,403 B1	Bates, III	Biometric device attachable to smart cards.
US 6,636,620 B1	Hoshino	Storing biometric information on smart cards.
US 2002/0034975 A1	Walker et al.	Slot machines with embedded smart card readers.
US 2002/0082084 A1	Snow et al.	Gaming machines with smart card readers and sensors,

18. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.



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